

Application No. 09/774,074
Response to 06/10/2005 Final Action

Attorney's Docket No. 10006308-1

REMARKS

Claims 1-20 are pending.

Claims 1-4, 6-12, and 14-20 stand rejected under 35 U.S.C. § 103(a) for obviousness over either a combination of U.S. Patents No. 5,991,515 to Fall et al. ("Fall") and No. 6,856,428 to Lermant et al. ("Lermant") or a combination of Fall and U.S. Patent No. 6,809,741 to Bates et al. ("Bates"). Claims 5 and 13 stand rejected for obviousness over either a combination of Fall, Lermant, and so-called "Applicant's described Background Art", in particular page 4, line 4, of this application, or a combination of Fall, Bates, and "Applicant's described Background Art".

These rejections should be reconsidered and withdrawn because none of Fall, Lermant, Bates, and the "Applicant's described Background Art" discloses or even suggests all of the features recited in Applicants' claims.

As explained in this application at page 5, line 3 et seq., among other places, Applicants' methods for formatting a document (claim 1) and formatting and compressing information contained within a document (claim 17) involve a division into multiple regions that is based on the colors of bodies of text. Such non-arbitrary division serves to preserve text color information at the same time as it eliminates the need for a separate color layer.

As explained in the Amendment filed in response to the previous Office Action, Fall does not disclose such operation. Instead, Fall's "bands" 112 are merely non-overlapping rectangular areas that have no relation to underlying objects. The deficiencies of Fall are not remedied by either Lermant or Bates.

Lermant describes determining whether a text object is "black text or other text". See col. 5, ll. 57-59. If the text is black text, Lermant saves "any underlying color background information" with the black text information and provides some kind of means for "combining the color background information with the black text information". See col. 5, ll. 61-65. If the text is "other text", it is processed "in a standard fashion". See col. 5, ll. 59-61.

If Lermant had been combined with Fall, all that could have resulted is Lermant's different processing of "black text" and "other text" in Fall's non-overlapping areas that still have no relation to underlying objects. Black text in different (Fall) non-overlapping

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areas might have been processed in the same (Lermant) way, but the text would not have determined the division into regions. Thus, Fall and Lermant are different from and have nothing to do with "dividing the document into regions" where each of a "plurality of the regions corresponds to text having the same color" as recited in claim 1, for example.

Bates describes selecting and applying a color combination for text and background based on a current color combination in order to replace a problem color combination with a preferred color combination. See Abstract. A combination of Bates and Fall would have had Fall's non-overlapping areas that have no relation to underlying objects, but with color combinations within Fall's areas being adjusted as in Bates. But this would have been merely an after-the-fact adjustment that, like the combination of Fall and Lermant, says nothing about "dividing the document into regions" where each of a "plurality of the regions corresponds to text having the same color" as recited in claim 1, for example.

With respect to claims 5 and 13, it is easy to see that the differences between the claimed subject matters and the combinations of Fall and Lermant or Bates discussed above are apposite and would not have been remedied by "Applicant's described Background Art".

As described above, the cited combinations do not describe all of the elements of Applicants' claims, and thus these combinations fail as bases for *prima facie* cases of obviousness against the claims.

It is also believed that the cited documents would not have supplied any motivation to combine them as suggested by the Action and that there would have been no reasonable expectation that such complex documents could be successfully combined to yield a working system, which even then would have had to be further modified to obtain the claimed subject matter. In view of the significant differences between the subject matters claimed and the citations, it is unnecessary to discuss in detail these other requirements of a *prima facie* case of obviousness. Accordingly, it is respectfully requested that the obviousness rejections be reconsidered and withdrawn.

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It is believed that this application is in condition for allowance, and an early Notice of same is earnestly solicited. If the Examiner has any questions, the undersigned attorney may be telephoned at the number given below.

Respectfully submitted,



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